

ESTTA Tracking number: **ESTTA651766**

Filing date: **01/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056509
Party	Defendant 3D Systems, Inc.
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Date	01/22/2015
Attachments	2015-01-22 3D Systems Reply Brief - Motion to Compel Oral Examination.pdf(318986 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Registrant: 3D Systems, Inc.
Mark: 3DS & Design
Reg. No.: 4,125,612 in Classes 1, 7, 9 and 40
Registered: April 10, 2012

Autodesk, Inc.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92056509
)	
3D Systems, Inc.,)	
)	
Respondent)	

**RESPONDENT’S REPLY TO PETITIONER’S OPPOSITION TO RESPONDENT’S
MOTION TO COMPEL DEPOSITIONS ON ORAL EXAMINATION**

A. Petitioner’s Gamesmanship Should Not be Rewarded

Petitioner, a U.S. company seeking to enforce a U.S. trademark registration before the U.S. Patent and Trademark Office, is gaming the system: taking undue advantage of the procedural limitations of the Trademark Rules, while attempting to deprive Respondent of a full and fair opportunity to obtain discovery with respect to witnesses that Petitioner intends to call to testify at trial. This is manifestly unfair. Petitioner claims a willingness to make its foreign witnesses available for live testimony at trial, when it benefits Petitioner, but manipulates the Trademark Rules of Practice to prevent Respondent from the benefit of depositions on oral examination – a benefit that is unquestionable. *See Century 21 Real Estate Corp. v. Century Life of America*, 15 USPQ2d 1079, at *1 (TTAB 1990) (ordering deposition on oral examination and noting that it “would be unjust for applicant to be deprived of the valuable aid of confronting the

witness by way of oral cross-examination...”).¹ As such, Respondent requests that the Board allow Respondent to depose all of Petitioner’s witnesses on oral examination and preclude Petitioner from calling to testify at trial any witness that is not made available for deposition on oral examination.

There is no question that it is disadvantageous for Respondent to depose witnesses on written questions – and Petitioner has provided no caselaw showing otherwise. *See e.g.* TBMP § 703.02(m) (“A deposition on written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions on direct examination have even been answered. Moreover, it deprives an adverse party of the right to confront the witness and ask follow-up questions on cross examination.”); *see also* 37 C.F.R. § 2.124 (listing the procedure for taking depositions on written questions, which can last upwards of two months, or more, from the date deposition notices are served).² Depositions on written questions allow for no opportunity for extensive or probing follow-up questioning immediately following the witnesses’ answers, nor will counsel be present to rephrase a question in an effort to resolve any potential confusion the witnesses may have with a written question, or to address a legitimate objection raised. And there can be no doubt that Petitioner will take every opportunity to object and resist answering written questions.

¹ The Board’s decision in *Century 21*, despite involving a witness living the U.S., still stands for the proposition that good cause must be demonstrated “so as to justify that the testimony of the witness be taken orally.” *Century 21*, 15 USPQ2d at *1. Petitioner incorrectly challenges the case law cited by Respondent in an effort to focus the Board’s attention not on the general rule of law articulated in each case but on an insignificant detail (location of the witness) that may be different—yet not distinguishable—from the instant case.

² The case law cited by Petitioner even speaks to the disadvantages of taking depositions on written questions. *See e.g. Leonid Nashin v. Product Source Int’l, LLC*, 2013 WL 6040375, *2 (TTAB 2013) (“In the normal course of a deposition on written questions, there is no opportunity to object to the responses to any questions until after the deposition is completed”).

Moreover, depositions on written questions allow Counsel for Petitioner to draft and craft answers to questions for witnesses – putting words into the witnesses’ mouths that they might not otherwise say. And Counsel for Respondent will not have the benefit of observing what part of the written questions is actually written by the witness, nor will they have the benefit of observing the demeanor of the witnesses during questioning. *See e.g. Orion Group Inc. v. The Orion Insurance Co., P.L.C.*, 12 USPQ2d 1923, at * 3 (TTAB 1989) (“It would be unjust...to deprive opposer of the opportunity of obtaining discovery and specifically of confronting and examining the witnesses by oral examination.”).³

Yet despite wanting to preclude Respondent from a full and fair opportunity to examine witnesses in discovery, Petitioner acknowledges in its response brief that it intends to call these same witnesses to testify orally in the United States during its trial testimony period. *See* TTABVUE 36 at p. 8. In further evidence of its gamesmanship, Petitioner speciously argues that these witnesses will be available for oral cross-examination by Respondent at trial – but Respondent will not be able to take full advantage of oral cross-examination at trial without the benefit of depositions on oral examination during the discovery phase. The Board should thus find good cause, and order Petitioner to produce its witnesses for deposition on oral examination.⁴

³ Contrary to Petitioner’s argument, *Orion* is not distinguishable from the instant case as both involve the application of Trademark Rule 2.120 to a deposition notice to depose by oral examination a witness living in a foreign country. The application of what constitutes “good cause” remains the same (weighing the equities, including the advantages of an oral deposition and any financial hardship that the party to be deposed might suffer if the deposition were taken orally in the foreign country) and “must be determined on a case-by-case basis, upon consideration of the particular facts and circumstances in each situation.” *Id.* at *3.

⁴ In the alternative, if the Board determines that Respondent must take depositions on written questions or Petitioner does not stipulate to make available the witnesses for oral depositions in Canada, the Board should preclude Petitioner from using such witnesses during the trial testimony period as Respondent will not be able to conduct adequate discovery in preparation for such testimony. *See e.g. Dickinson v. Fairly Bike Mfg. Co. Ltd.*, 1993 WL 147275, at *1 (E.D. Pa. 1993) (Defendant ordered not to “present, in its case in chief, the trial testimony of any witness who has not previously been made reasonably available for a deposition.”).

B. Respondent Had No Obligation to Independently Determine the Location of
Petitioner's Witnesses

Contrary to Petitioner's argument, Respondent is not required to perform an independent search to determine the location of an opposing party's key witnesses, as that location must be provided in the party's initial disclosures. Fed.R.Civ.P. 26(a)(1) ("[A] party must...provide to the other parties...the name and, if known, the address and telephone number of each individual likely to have discoverable information..."). Instead, Respondent is entitled to rely on the information provided by Petitioner in its initial disclosures, especially as Petitioner's Counsel made no other contention in subsequent discovery responses contradicting Petitioner's previous statement that the witnesses would be made available through counsel. Petitioner's Counsel cannot now come—after previously filing its own Motion to Compel effectively suspending the proceeding and hindering Respondent from filing its own Motion to Compel before the August 27, 2014, discovery deadline—and object to Respondent's notices of deposition as "facially invalid" and purport to require Respondent to perform a "Google search" to determine the proper location of Petitioner's key witnesses prior to serving deposition notices. *See* TTABVUE 36 at p. 7 n.7. Petitioner's Initial Disclosures clearly and unequivocally stated that the identified witnesses could be contacted through Counsel for Petitioner, located in California, and that is ***exactly*** what Respondent did when noticing the depositions. TTABVUE 32 at Exhibit A.

Likewise, Petitioner's argument that Respondent "answered discovery propounded by Petitioner concerning the location of Respondent's witnesses in the exact same manner" is irrelevant: Respondent's witnesses are all located in the U.S. and available for deposition on oral examination at times and locations mutually convenient to the parties. TTABVUE 36 at p. 7. It is Petitioner alone who has withheld information and intentionally delayed the discovery process

and only disclosed the true location of its witnesses when objecting to Respondent's duly served deposition notices complying with the information provided by Petitioner in its initial disclosures.

C. Respondent's Discovery Period Was Not Closed by the Board's October 30, 2014 Order

Petitioner's argument that the Discovery Period for Respondent closed on October 30, 2014 is without basis. The language of the Board's Order is unequivocal: "[d]iscovery closes for **both parties**" on December 30, 2014. TTABVUE 29 at p. 7 (emphasis added). But to the extent that the Board intended something other than what it wrote, Respondent can clearly show excusable neglect for not filing a motion to compel until December 13, 2014.

First, Respondent relied on Petitioner's Initial Disclosures and Discovery Responses in serving deposition notices on key witnesses for Petitioner, and Petitioner did not make Respondent aware of the true location of its witnesses – and its consequent objections to the deposition notices – until AFTER the Suspension Order was in effect. TTABVUE 32 at Exhibit E at p. 2. Respondent, who had 19 days left in the discovery period when the proceeding was suspended, was thus **precluded** from filing a Motion to Compel with respect to this issue, and thus could not file the instant motion until after the Board issued its Order on Petitioner's Motion to Compel and Respondent filed its Motion for Reconsideration in Part on November 29, 2014.⁵ TTABVUE 29, 30. Respondent, relying on the language in the Board's Order indicating that the close of discovery for both parties was not until December 30, 2014, did not believe that its

⁵ Given this preclusion and in view of Counsel for Petitioner's refusal to provide Respondent's Counsel with dates and times Petitioner's Counsel was available to meet and confer, Respondent elected to adjourn its deposition notices *sine die*. TTABVUE 32 at Exhibit D. This adjournment was in an effort to allow the parties to focus on Petitioner's Motion to Compel and the forthcoming Board Order as well as waiting until such a time as Autodesk's production and discovery responses were sufficiently complete.

discovery period had closed, and thus did not believe that it was required to move immediately on receipt of the Board's Order on October 30, 2014.

Secondly, Respondent filed this Motion *less than 48 hours* after Petitioner took the position that the discovery period had closed for Respondent – an interpretation of the Board's October 30, 2014 Order that Respondent did not agree with given the unequivocal language contained in the Order (“[d]iscovery closes for *both parties*” on December 30, 2014). TTABVUE 29 at p. 7 (emphasis added).

Additionally, there exists no measurable prejudice to Petitioner should the Board extend Respondent's discovery period for the limited purpose of allowing Respondent to take the oral depositions of Petitioner's key witnesses. The only possible prejudice Petitioner can argue is a slightly extended discovery period—an extension that Petitioner acknowledges is required for Petitioner to be able to complete its own discovery. Moreover, “the mere passage of time is generally not considered prejudicial, absent the presence of other facts, such as the loss of potential witnesses,” *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, at *3 (TTAB 2002). Further, Petitioner “will bear no greater cost in defending this matter” than it would have if Respondent attempted to depose Petitioner's witnesses before the passage of the former discovery deadline of August 27, 2014, as Petitioner's position on the deposition of its foreign witnesses is immutable, and Respondent would have still had to seek Board intervention due to Petitioner's failure to stipulate to provide witnesses for deposition on oral examination. *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, at *2 (TTAB 1998).

Second, a reopening of the discovery period would not cause substantial delay nor would the potential impact on the judicial proceedings be significant. In reality, granting Respondent's motion and allowing Respondent to take critical depositions on oral examination would be vastly

more efficient and expeditious than requiring the depositions be taken on written questions – a process that can take months to complete, and can require suspension of the proceeding. *See e.g. Brad W. House v. Dorothy Wong*, 2010 WL 5522990, at *3 (TTAB 2010) (“A copy of the notice of the deposition (but not the questions) is to be filed with the Board to allow for ***suspension of the case*** and an orderly taking of the deposition”) (emphasis added); *see also* 37 C.F.R. § 2.124(b)(1) and (d)(2)).

Third, Respondent’s alleged failure to complete discovery by August 27, 2014, was not within its reasonable control as Respondent was precluded by Order of the Board from filing the instant motion until after the Board-ordered suspension was lifted.

Similarly, under the fourth factor, Respondent’s reliance on the unequivocal language of the Board’s Order that the discovery period for both parties closed on December 30, 2014 was clearly made in good faith, and was such reliance was logical in view of the fact that there were still 19 days left in the discovery period when Petitioner prematurely moved to compel, resulting in suspension of the proceedings. Petitioner’s discussion on whether Respondent did or did not act promptly is a straw man argument in its purest form. The Board’s Suspension Order dated August 8, 2014 was clear: “Proceedings are suspended pending disposition of Petitioner’s motion to compel filed on August 7, 2014, except as discussed below. The parties should not file any paper which is not germane to the motion to compel.” TTABVUE 26 (emphasis in original); *see also* TBMP § 523.01(2) (“When a party files a motion for an order to compel...discovery, the case will be suspended by the Board with respect to all matters not germane to the motion.”). Once the Board suspended the proceeding, neither Respondent nor Petitioner had the burden of following the trial schedule as previously set by the Board on April 12, 2014. *See e.g. Prakash Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, at * 2 (TTAB 2010) (“Both parties bear the

responsibility for following the trial schedule as ordered unless and until the Board issues a suspension order or otherwise resets the trial dates.”)

D. Conclusion

For the foregoing reasons, Respondent respectfully requests that the Board grant Respondent’s Motion to Compel Depositions on Oral Examination in its entirety and: (1) order that the depositions of Petitioner’s witnesses may be taken on oral examination where those witnesses are located (whether Canada or the United States); and (2) reset the discovery period to allow sufficient time for Respondent to complete discovery.

Dated: January 22, 2015

Respectfully Submitted,

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Certificate of Filing / Certificate of Service

The undersigned hereby certifies that the foregoing *Respondent's Opposition to Petitioner's Motion to Compel* was filed via ESTTA, and that a copy was placed in U.S. Mail, postage prepaid, addressed to the following counsel of record:

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This the 22nd day of January, 2015.

/s/ Gina Iacona
An Attorney for Respondent

